AF/ gp2172

Docket No. CITI00127-US PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the U.S. Application of

Daniel SCHUTZER Group Art Unit: 2172

U.S. Serial No.: 09/409,748

Examiner: PHAM, H.

Filed: October 1, 1999

For: SYSTEM AND METHOD OF USING E-MAIL CENTERED INTERNET INTERACTION

APPEAL BRIEF

Commissioner for Patents
U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop **Appeal Brief - Patents**
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

This is an Appeal Brief under the new Rules of Practice Before the Board of Patent Appeals and Interferences, Board Rule 41.37 (Effective September 13, 2004), in connection with the decisions of the Examiner in a Final Office Action dated April 1, 2004 (hereinafter, "the Final OA"), and an Advisory Action dated September 28, 2004. Each of the topics required by Board Rule 41.37 is presented herewith and is labeled appropriately.

(1) Real Party In Interest

The real party in interest is Citibank, N.A.

(2) Related Appeals And Interferences

01/04/2005 SSITHIB1 00000079 09409748
02 FC:1253 1020.00 OP

01/04/2005 SSITHIB1 00000079 09409748
01 FC:1402 500.00 OP

There are no other appeals or interferences related to this case.

(3) Status Of Claims

Claims 1, 3-5, and 7-14 are pending and rejected. Claims 1, 3-5, and 7-14 are hereby appealed.

(4) Status of Amendments

An amendment subsequent to the Final OA was mailed on August 2, 2004. Such after-final amendment seek to simplify the claimed invention by merely incorporating the subject matter of dependent claim 2 into its independent claim 1. The Examiner has reviewed the after-final amendment and denied entry of such amendment.

(5) Summary Of The Invention

The present invention is related to a system and method of using an e-mail system that retrieves web pages and links to web pages and returns them to a user in an e-mail message. According to one embodiment of the present invention, there is provided a method of attaching at least one Web page to an e-mail message comprising: receiving at least one search term via e-mail; issuing a search request to a search engine using the at least one search term; receiving a hit list from the search engine; retrieving at least one Web page from the hit list; bundling a copy of the at least one Web page into an e-mail message; and forwarding the e-mail message to an end-user's terminal wherein the copy of the at least one Web page may be reviewed by the end-user. *See* Figure 1, pp. 8-10.

According to another embodiment of the present invention, there is provided a method of attaching a copy of at least one entire Web page to a first e-mail message comprising: receiving an address associated with the at least one entire Web page; retrieving the at least one entire Web page; automatically bundling a copy of the at least one entire Web page into the first e-mail message; and automatically forwarding the first e-mail message to a user's terminal wherein the copy of the at least one entire Web page may be retrieved and reviewed by the user at the user's terminal. *See* Figure 1, pp. 8-10.

According to still another embodiment of the present invention, there is provided a computer readable medium for controlling a system, including a client terminal and a server, so the system's operations comprise: receiving at least one search term at the client terminal; bundling the at least one search term into a first message at the client terminal; forwarding the first message from the client terminal to the server; issuing the at least one search term as a search request from the server to a search engine; receiving links to a plurality of Web pages that are associated with the at least one search term at the server; issuing a request for at least one of the plurality of Web pages; receiving the at least one Web page by the server; the server automatically copying the at least one Web page into at least one e-mail message by the server; and the server automatically forwarding the at least one e-mail message from the server to the client. *See* Figures 1-2 and accompanying text.

(6) Grounds of Rejection Presented for Review

The Examiner's denial of entry of the amendment dated August 2, 2004, which would have simplified the issues on appeal.

Claim 2 stands rejected under 35 U.S.C. 103(a) by Hussey (USP No. 6,230,156) in view of Harvey (Internet Explorer 4 for Windows for Dummies Quick Reference) and Adams et al. (U.S.P. No. 6,334,145).

Claims 3, 5, 7, and 13-14 stand rejected under 35 U.S.C. 103(a) by Navin-Chandra et al. (U.S.P. No. 6,275,820).

Claims 4, 8, and 12 stand rejected under 35 U.S.C. 103(a) by Navin-Chandra et al. in view of Adams et al.

(7) Arguments

The Examiner's denial of entry of the amendment dated August 2, 2004

In the Advisory Action dated September 28, 2004, the Examiner denied entry of the amendment dated August 2, 2004, because claims 1 and 3 were amended, which raised new issues that require further consideration. It is respectfully submitted that the only changes made in the amendment dated August 2, 2004, was the incorporation of dependent claim 2 into independent claim 1. As for the other changes that "raised new issues," i.e., "retrieving at least one Web page ~~based on~~ from the hit list" in claim 1 and "retrieving the at least one entire Web page" in claim 3, it is respectfully submitted that such changes were made in an earlier amendment dated February 13, 2004. Thus, such changes as shown in the after-final amendment

were mere typographical errors. Accordingly, it is respectfully submitted that the after-final amendment be entered.

The rejection of claim 2 under 35. U.S.C. § 103(a) as being upatentable over Hussey in view of Harvey and Adams et al. is not proper

The Examiner rejected claim 2 by combining three references: Hussey, Harvey, and Adams et al. Specifically, the Examiner asserted that col. 11, lines 10-44 in Adams et al. shows that "a user could select the depth of sub links for searching and the result is placed in a folder," which can be read into the claimed feature of ***receiving a number representative of a depth in which the depth is the amount another web page is removed from the at least one Web page***. Thus, "it would have been obvious for one of ordinary skill in the art...to modify the Navin-Chandra method by including the technique...as taught by Adams." Final OA, p. 8.

First, as admitted by the Examiner, Adams et al. at best shows that links and sub-links are placed in a folder, wherein the sub-links may be removed from a targeted Web page by a certain depth. Therefore, it does not show the receiving of ***a number representative of such depth*** as claimed. Second, as also admitted by the Examiner, at best it would have been obvious to combine the ***Navin-Chandra method*** to include the technique as taught by Adams et al. However, it is the combination of Hussey and Harvey, not the Navin-Chandra method, that the Examiner used to reject claim 2. Therefore, the Examiner has not established a prima facie case of obviousness based on ***Hussey***, ***Harvey***, and ***Adams et al.***

For at least the above reasons, it is respectfully submitted that amended claim 1 and dependent claims 9-11 are allowable over the references of record. Should the Examiner

believes that it would have been obvious to combine ***Hussey, Harvey***, and ***Adams et al.*** to reject the amended claim 1, it is requested that the FINALITY of the outstanding Office Action of 4/1/04 be withdrawn, and another NON-FINAL Office Action be issued.

The rejection of claims 3, 5, 7, and 13-14 under 35 U.S.C. 103(a) as being unpatentable over Navin-Chandra et al. (U.S.P. No. 6,275,820) is not proper

As stated in a previous Amendment, as pointed out by the Examiner, Navin-Chandra et al. disclose in Col. 11, lines 58-67 that each of the search engine results being a ***portion*** of a respective original document. Therefore, there is no bundling of a copy of at least ***one*** entire web page into an e-mail message for forwarding the user's terminal as claimed and asserted by the Examiner to be disclosed by Navin-Chandra et al.

To rebut the above arguments, the Examiner asserted that FIG. 2 and associated text in Navin-Chandra discloses the results of MSE 262 are converted into e-mail, and "by converting into e-mail, obviously, the document as discussed or an entire web page is bundled into an e-mail message." Yet, Navin-Chandra et al. does not specifically indicate an ***entire*** web page is bundled. Indeed, as specifically pointed out in col. 11, lines 58-67, only a portion of a respective original document is included in the search engine results; therefore, entire documents are not even initially acquired for subsequent bundling.

For at least the above reasons, it is respectfully submitted that claims 3, 5, 7 and 13-14 are allowable over the references of record.

The rejection of claims 4, 8 and 12 under 35 U.S.C. 103(a) by Navin-Chandra et al. in view of Adams et al. is not proper

Claims 4, 8, and 12 are allowable for at least the aforementioned reasons for the allowance of claims 3, 5, 7, 13 and 14.

Conclusion

For at least the reasons given above, the rejections of claims 1, 3-5, and 7-14 are improper. It is respectfully requested that such rejections by the Examiner be reversed and these claims be allowed. Attached below for the Board's convenience is an Appendix of claims 1, 3-5, and 7-14 as currently pending.

Respectfully submitted,

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(9) Appendix

1. A method of attaching at least one Web page to an e-mail message comprising:

receiving at least one search term via e-mail;

issuing a search request to a search engine using the at least one search term;

receiving a hit list from the search engine;

retrieving at least one Web page from the hit list;

bundling a copy of the at least one Web page into an e-mail message; and

forwarding the e-mail message to an end-user's terminal wherein the copy of the at least one Web page may be reviewed by the end-user.

2. The method of claim 1 further comprising:

receiving a number representative of a depth in which the depth is the amount another Web page is removed from the at least one Web page; and

bundling a copy of each link between the other Web page and the at least one Web page into the e-mail message.

3. A method of attaching a copy of at least one entire Web page to a first e-mail message comprising:

receiving an address associated with the at least one entire Web page;

retrieving the at least one entire Web page;

automatically bundling a copy of the at least one entire Web page into the first e-mail message; and

automatically forwarding the first e-mail message to a user's terminal wherein the copy of the at least one entire Web page may be retrieved and reviewed by the user at the user's terminal.

4. The method of claim 3 further comprises:

generating the address based upon a request to review the at least one entire Web page that is linked to a copy of another Web page wherein the copy of the other Web page is bundled in a second e-mail message; and

forwarding the second-email message to the user's terminal wherein the copy of the other Web page may be retrieved and reviewed by the user at the user's terminal.

5. A computer readable medium for controlling a system, including a client terminal and a server, so the system's operations comprise:

receiving at least one search term at the client terminal;

bundling the at least one search term into a first message at the client terminal;

forwarding the first message from the client terminal to the server;

issuing the at least one search term as a search request from the server to a search engine;

receiving links to a plurality of Web pages that are associated with the at least one search term at the server;

issuing a request for at least one of the plurality of Web pages;

receiving the at least one Web page by the server;

the server automatically copying the at least one Web page into at least one e-mail message by the server; and

the server automatically forwarding the at least one e-mail message from the server to the client.

6. (Canceled).

7. The computer readable medium of claim 5, wherein the at least one Web page comprises a sub-plurality of the plurality of Web pages.

8. A computer readable medium for controlling a system, including a client terminal and a server, so the system's operations comprise:

receiving at least one search term at the client terminal;

bundling the at least one search term into a first message at the client terminal;

forwarding the first message from the client terminal to the server;

issuing the at least one search term as a search request from the server to a search engine;

receiving links to a plurality of Web pages that are associated with the at least one search term at the server;

issuing a request for at least one of the plurality of Web pages, wherein the at least one Web page comprises a sub-plurality of the plurality of Web pages;

receiving the at least one Web page by the server;

copying the at least one Web page into at least one e-mail message by the server; and

forwarding the at least one e-mail message from the server to the client;

wherein the at least one e-mail message comprises a plurality of e-mail messages, and at least one of the sub-plurality of Web pages is copied into one of the plurality of e-mail messages.

9. The method of claim 1, wherein the copy of the at least one Web page bundled in the e-mail message may be reviewed by the end-user when the end-user's terminal is not connected to the Web.

10. The method of claim 1, wherein the bundled at least one Web page includes a link to a non-retrieved Web page, wherein the non-retrieved Web page can be retrieved directly via connection to the Internet.

11. The method of claim 10, wherein the non-retrieved Web page can be retrieved upon receiving another search term and issuing another search request to the search engine using the another term.

12. A method of attaching at least one Web page to an e-mail message comprising:

receiving at least one search term;

issuing a search request to a search engine using the at least one search term;

receiving the hit list from the search engine;

retrieving at least one Web page based on the hit list;

bundling a copy of the at least one Web page into an e-mail message; and

forwarding the e-mail message to an end-user's terminal wherein the copy of the at least one Web page may be reviewed by the end-user;

wherein the bundled at least one Web page includes a link to another retrieved Web page, wherein a copy of the another retrieved Web page is also bundled into the e-mail message.

13. The computer readable medium of claim 5, wherein the server is an e-mail server.

14. The computer readable medium of claim 5, wherein the client terminal is off-line with the Internet, and the server is connected to the Internet.